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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,012	10/05/1999	ALBERT K. CHIN	26448-04496	1400
758 7590 11/12/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
11/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/413,012

Applicant(s)

CHIN, ALBERT K.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34, 35, 37-44, 46-50, 54 and 64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 34, 35, 37-44, 46-50, 54 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 9/21/2007.

DETAILED ACTION

1. The Remark filed 6/20/2008, with respect to claims 34,35,37-44,46-50,54 and 64 and the Terminal disclaimer are acknowledged. However, upon further consideration, a new ground(s) of rejection is made in view of Goodwin et al and Ianniruberto. Rejections based on the cited reference(s) follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34,37,41-42 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al 5,817,061 in view of Ianniruberto et al 5,226,890.

Goodwin et al disclose in figures 2 and 6-7, a surgical device including: a distal tip 17 has tapered outer wall converging to a blunt end, the tip disposed on the distal end of a cannula 13, where a dilating element 15 disposed on the cannula, where the dilating element has a cross sectional dimension which is greater than the cross sectional dimension of the distal end of the cannula and greater than the cross sectional dimension of the distal tip (see fig. 7), where the dilating element further comprises a threaded bore hole (occurs along segment 27) formed in the dilating element, But Goodwin is silent regarding a length screw threads positioned on an outer surface of the cannula.

Ianniruberto et al teach a length screw threads 114 positioned on an outer surface of the cannula (fig. 4). It would have been obvious to one having ordinary skill in the art at the

time the invention was made to modify Goodwin by constructing a length screw threads positioned on an outer surface of the cannula as taught by Ianniruberto in order to have optimal entry and removal of the dilating element on the cannula. Regarding claims 37 and 41-42, Goodwin et al disclose the device further has an endoscope 24, and the exterior contour of the dilating element is an oval shape (see fig. 6) which has some sore of compressible to a certain degree while providing access to a surgical site within a body cavity of a patient.

Claims 43,46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al 5,817,061. Goodwin et al disclose the invention substantially as claimed, but Goodwin is silent regarding a plurality of dilating elements each adapted to mount on the cannula. It is noted that Goodwin does disclose a locking mechanism 37 positioned on the cannula 13, a dilating element 15 mounted on the cannula. At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to modify Goodwin's device with a plurality of dilating elements because Applicant has not disclosed that the plurality of dilating elements provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Goodwin device, and applicant's invention, to perform equally well with either the device taught by Goodwin because both device would perform the same function of providing access to surgical sites within cavity of patient during surgical procedures.

Therefore, it would have been obvious to modify Goodwin to obtain the invention as

specified in the above claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Goodwin. Regarding claims 46 and 50, Goodwin et al disclose the device further has an endoscope 24, and the exterior contour of the dilating element is an oval shape (see fig. 6).

Claims 35 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al 5,817,061 in view of Ianniruberto et al 5,226,890.

Goodwin et al in view of Ianniruberto et al teach the invention substantially as claimed (see rejection of claim 34 above). Goodwin et al in view of Ianniruberto is silent regarding the dilating element is solid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device included a dilating element is solid, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use or as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 38-40,47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin et al 5,817,061 in view of Ianniruberto et al 5,226,890.

Goodwin et al in view of Ianniruberto et al teach the invention substantially as claimed (see rejection of claim 34 and 43 above). Goodwin et al in view of Ianniruberto is silent regarding the dimension of the dilating element is between 15-30 mm and a spacer length of cannula of between 14-28 mm or the dilating element is at least two times larger than the dimension of the distal end of the cannula. It would have been obvious matter of design choice to modify the dimension of the dilating element is between 15-30mm and a spacer length of

cannula of between 14-28 mm or the dilating element is at least two times larger than the dimension of the distal end of the cannula, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re.Aller, 220F, 2D 454,105 USPQ 233.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/Victor X Nguyen/
Examiner
Art Unit 3734

VN